

REMARKS

Applicant has amended claim 11 in the manner suggested by the Examiner to place the claim in condition for allowance. Support for the amendment can be found in the specification at page 9, lines 25-28, and at page 16, lines 15-18. Applicant has also cancelled claims 12-14. Finally, Applicant has amended the specification as suggested by the Examiner to reflect the current status of the patent applications cited in pages 17 and 18 of the specification.

No new matter has been introduced by the above amendments, which are submitted without waiver or prejudice to Applicant's ability to pursue any subject matter cancelled thereby in any continuing patent application. Claims 10 and 11 are currently pending. Reconsideration of the application, as amended, is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 10-14 for allegedly failing to comply with the written description requirement, and suggests that "(a) data be provided which demonstrates that the [sic] compound of claim 10 can bind to the GLP-1 receptor, (b) the term "pharmaceutical" be deleted from claim 11, (c) the term "effective amount" be deleted from claim 11, and (d) that claims 12-14 be cancelled." See the Instant Office Action, page 6, lines 20-23.

Regarding the Examiner's suggestion (a), Applicant notes that the Examiner has provided no reason to question the ability of the compound of claim 10 to bind to the GLP-1 receptor. However, notwithstanding this omission, and solely to facilitate a better understanding of Applicant's invention, Applicant provides herewith receptor binding assay data which demonstrate that the compound of claim 10 binds to the GLP-1 receptor. See Declaration under 37 C.F.R. § 1.132, attached hereto as "Exhibit A."

Regarding the Examiner's suggestions (b) and (c), without conceding the correctness of the Examiner's allegations and solely to place the current application in better condition for allowance, Applicant has amended claim 11 to delete the terms "pharmaceutical" and "effective amount."

Finally, regarding the Examiner's suggestion (d), again without conceding the correctness of the Examiner's allegations and solely to place the current application in better condition for allowance, Applicant has cancelled claims 12-14.

In view of the above, Applicant respectfully submits that the rejection of claims 10-14 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement has been obviated.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 11-13 as being indefinite. Applicant respectfully traverses.

The Examiner states:

Claim 11 recites an "effective amount" of a compound, but does not recite any objective of the efficacy. Accordingly, the claim is indefinite as to objectives.

Claim 12 is drawn to a method of eliciting an "agonist effect". This claim is indefinite as to the manifestations of the agonist effect. Suppose that there are two rats, and one is given a compound of claim 10, and the other is given "vehicle" only. If the two rats were determined to be identical by a series of biochemical and physiological tests, would applicants argue that an "agonist effect" had been realized?

Claim 13 recites the term "metabolic disorder". This renders the claim indefinite as to the disease(s) which may be encompassed.

Claim 13 is indefinite as to the manifestations of a successful treatment. For example, suppose that the compound of claim 10 were administered to a human subject suffering from Alzheimer's Disease, and that as a result of the administration, there was a measurable change in serum glucose. Would this be considered a successful treatment?

(See the Instant Office Action, page 7, lines 4-19)

As discussed above, Applicant has amended claim 11 to delete the term "effective amount," and cancelled claims 12-13. Thus it is respectfully submitted that the rejection of claims 11-13 under 35 U.S.C. § 112, first paragraph, as allegedly being indefinite has been overcome.

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CONCLUSION

Applicants submit that each ground for rejection asserted by the Examiner in the Instant Office Action has been removed. On this basis, it is submitted that both claims 10 and 11 are now in condition for allowance, and notification to that effect is earnestly requested.

Please apply any additional charges due for this submission to deposit account 06-1050, referencing Attorney's Docket No. 00537-186002.

Respectfully submitted,

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